

Appl. No. 09/161,283

Amendment Dated January 11, 2005

Response to Advisory Action of October 19, 2004 and Office Action of April 4, 2004

### REMARKS

Applicant acknowledges the Examiner's careful review of this application.

Applicant does, however, respectfully request reconsideration and allowance.

Applicant submits this Amendment as a re-write of the Examiner's constructive proposal of December 30, 2004, which is acknowledged with appreciation.<sup>1</sup> The claims as proposed by the Examiner have been revised, such as the additive being described consistent with the specification and Applicant's prior proposals.<sup>2</sup> It is noted that the linguistic format for "additive" otherwise follows the Examiner's proposals and is presented in an effort to bring this prosecution to a close. The resin layer (A) recitals in proposed amended claims 1 and 18 include language from claims 11 and 19 respectively, while adapting the Examiner's proposed "optional" language for the additive for resin layer (A) being (iii) in the proposed amended claims. It is respectfully submitted that such approach will avoid extra independent claims. Dependent claims 11 and 12 are amended based on the discussions and the Examiner's proposals and are thought properly dependent from the proposed amended claim 1. Applicant respectfully submits that dependent claims 19 and 20 are likewise properly dependent from the proposed amended claim 18. Amended claims 2 and 5 are presented in an effort to adapt what Applicant understood the Examiner would accept linguistically, albeit without truncating claim scope. Applicant has made a good faith effort to present an amended format for claim 17 in an effort to advance prosecution.

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<sup>1</sup> Applicant appreciates the Examiner's patience.

<sup>2</sup> The claims presented herewith present language that is the same as presented on September 29, 2004 but with a corrected Markush Group. The corrected Markush Group was discussed with the Examiner on October 4, 2004.

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**Support for the Claim Amendment**

The Amendment does not raises a new issue and does not present new matter. Applicant therefore earnestly but respectfully, requests the Examiner to enter this Amendment.

It is respectfully submitted that the resin layer (A) is described in the amended claims 1 and 18 consistent with the original specification at, for instance, page 13, lines 10-16.

It is thought that the insoluble methyl-methacrylate particles are described in the amended claims 1 and 18 consistent with Applicants' original specification at, for example, page 9, lines 8-12, page 10, lines 1-8, page 11, lines 3-8 and from page 16, line 22 to page 17.

Applicant has deleted the expression "have a uniform composition" with reference to the insoluble methyl methacrylate particles. Such deletion is without prejudice.

Applicant has deleted the expression "resin layer (A) has no insoluble methyl methacrylate particles." Such deletion is without prejudice. The Examiner is urged to re-review the Examples relating preparation of resin (A) from which it will be apparent that the language had support in the application as originally filed. One has only to add up the amounts to see this.

**Rule 133 Statement**

The application was discussed with the Examiner on May 5, 2004, and has been discussed again at various subsequent times. Recent discussions were held again in December 2004, including on December 30, 2004, and thereafter again several times in January 2005, including January 6, 2005 and most recently on January 10, 2005. Applicant respectfully submits that consisting essentially should be acceptable in defining

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resin layer (A)<sup>3</sup> and authorizes an Examiner's Amendment to such effect as related in Applicant's prior submissions and discussions with the Examiner.

Applicant's legal representative is available to conduct a further interview but the presence of the Supervisory Examiner is respectfully, but specifically, requested.

**Amendment Reduces Issues for Appeal**

The Advisory Action refers to the September 29, 2004 Amendment and states "[t]he Examiner acknowledges that the proposed amendments would be sufficient to overcome the outstanding 35 U.S.C. 112, first paragraph rejections."

Issues for any appeal would be reduced since the Examiner has already stated on the record that the 35 U.S.C. §112(f) rejections would be overcome.

Entry of this Amendment is therefore respectfully, but earnestly solicited.

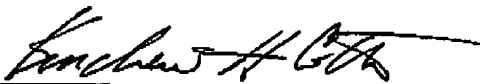
**Conclusion**

Applicant very earnestly, but respectfully, solicits favorable consideration of this Amendment followed by a Notice of Allowance.

CUSTOMER NO. 42798

Respectfully submitted,

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<sup>3</sup> While Applicant have amended claims 1 and 18 to use 'consisting of' in an effort to bring this six year prosecution to close, it is very earnestly suggested that the Examiner re-consider the rejection. Applicant earnestly request the Examiner to re-review the Examples for preparing resin (A) whereupon the basis for the language previously objected to (resin (A) not including insoluble methyl methacrylate particles or 'resin (A) consisting essentially of'). Applicant respectfully requests the Examiner to withdraw the rejection, and to reconsider the language 'consisting essentially of' - which Applicant authorizes the Examiner to enter by an Examiner's Amendment.